

The opinion in support of the decision being entered today was *not* written for publication in and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CHARLES KORMANIK JR.

Appeal No. 2006-1451
Application No. 08/802,472
Technology Center 3600

Decided: March 12, 2007

Before JENNIFER D. BAHR, LINDA E. HORNER¹ and ANTON W. FETTING,
Administrative Patent Judges.

ANTON W. FETTING, *Administrative Patent Judge.*

DECISION ON REQUEST FOR REHEARING

This is a decision on the request for reconsideration, filed under 37 CFR § 41.52, of our decision in this appeal.

On Aug. 21, 2006, we mailed our decision to the Appellant's appeal in the instant application. In our decision, we made two new grounds of rejection under 37 CFR § 41.50(b). One ground was against claims 18 and 19 under 35 U.S.C.

¹ Judge Frankfort, one of the original panel members in this appeal has since retired and Judge Horner has been designated as his replacement. MPEP 1214.03, last paragraph.

§ 112, first paragraph as not being fully described in the originally disclosed written description to the extent of the scope of the claim, and the other ground was against claims 5, 17 to 24, 27 to 31 and 49 to 58 under 35 U.S.C. § 112, second paragraph. The Appellant filed a paper on Oct. 16, 2006, styled “REQUEST FOR REHEARING TO Sec. 37 C.F.R. 41.52” during the two month period in which the instant application remained under this board’s jurisdiction. This request for rehearing is directed solely toward those rejections.

We GRANT the request for rehearing to the extent we have reconsidered our decision, but DENY the request to withdraw the new grounds of rejection.

REJECTIONS UNDER CONTENTION

We rejected claims 18 and 19 under 35 U.S.C. § 112, first paragraph as not being fully described in the originally disclosed written description to the extent of the scope of the claim. A claim to the shape of the outer packaging is described in the specification only to the extent of a box that is shaped to resemble the type of box the iconic shape is ordinarily enclosed in, not to the extent that it is shaped to resemble any activity visually suggested by the iconic shape. Therefore, the scope of the rejected claims is not commensurate with the scope of its written description.

We rejected claims 5, 17 to 24, 27 to 31 and 49 to 58 under 35 U.S.C. § 112, second paragraph, because the characterization of the claimed subject matter as “recognizable”, “visually suggestive”, and “associated with” are totally subjective to each individual, obviating any possibility of pointing out the scope of the claims with any degree of particularity.

As to the rejection under 35 U.S.C. § 112, first paragraph, the Appellant contends that claims 18-19 are supported by the specification, p. 15, lines 28-31:

a preferred embodiment is to locate the thematically-shaped packaging within other suggestive packaging-preferably suggestive by virtue of it's [sic, its] shape too.

As to the rejection under 35 U.S.C. § 112, second paragraph, the Appellant contends that federal trademark law provides an objective standard of the attribute of being “visually suggestive” (Rehearing Request 2), and that the attribute of being “recognizable” is consistent with trademark law. As further support, the Appellant contends that this issue had been raised previously and was not pursued. The Appellant also contends that prohibiting the use of trademark law standard in thematic packaging precludes the possibility of claiming the particular type of invention at issue. (Rehearing Request 3).

The Appellant also contends entitlement to consistent claim interpretation (Rehearing Request 3-4) and further contends that this has not been provided (Rehearing Request 4-5). The Appellant has not requested that any particular rejection ought to be reheard based on these contentions, and are therefore moot.

PERTINENT FACTS

Regarding the rejection under 35 U.S.C. § 112, first paragraph, claim 18 recites the limitation that the outer layer of packaging is shaped to visually suggest the associated activity of claim 5.

This claim was not present upon the Feb. 18, 1997 filing of the application, but was added by a subsequent amendment filed Jun. 22, 1998.

The support for this limitation in the originally filed specification is that as indicated by the Appellant above.

Regarding the rejection under 35 U.S.C. § 112, second paragraph, exemplary claim 5 recites

5. A method for making a combination of a thematic package and an article contained in the package for combined marketing, the method including the steps of:

constructing the package as a replica of a *recognizable* icon, the package having a shape that is different than any shape to be contained therein,

the shape of the package *visually suggestive* of an activity *associated with* the icon in which the article is used during the activity, after removal from the package,

the package having a hollow interior;

locating the article within the hollow interior of the package to form the combination of the article and the thematically-shaped package; and

marketing the combination. (emphasis added).

PRINCIPLES OF LAW

With regard to our rejection under 35 U.S.C. § 112, first paragraph, this statutory provision requires that the "specification shall contain a written description of the invention" This requirement is separate and distinct from the enablement requirement. See, e.g., *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1560, 19 USPQ2d 1111, 1114 (Fed. Cir. 1991). The written description

requirement has several policy objectives. "[T]he 'essential goal' of the description of the invention requirement is to clearly convey the information that an applicant has invented the subject matter which is claimed." *In re Barker*, 559 F.2d 588, 592 n.4, 194 USPQ 470, 473 n.4 (CCPA 1977). The written description requirement of the Patent Act promotes the progress of the useful arts by ensuring that patentees adequately describe their inventions in their patent specifications in exchange for the right to exclude others from practicing the invention for the duration of the patent's term.

To satisfy the written description requirement, a patent specification must describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention. See, e.g., *Moba, B.V. v. Diamond Automation, Inc.*, 325 F.3d 1306, 1319, 66 USPQ2d 1429, 1438 (Fed. Cir. 2003). An applicant shows possession of the claimed invention by describing the claimed invention with all of its limitations using such descriptive means as words, structures, figures, diagrams, and formulas that fully set forth the claimed invention. *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997).

With regard to our rejection under 35 U.S.C. § 112, second paragraph, our reviewing court has held that

Reference to undefined standards, regardless of whose views might influence the formation of those standards, fails to provide any direction to one skilled in the art attempting to determine the scope of the claimed invention.

Datamize, LLC v. Plumtree Software, Inc., 417 F.3d 1342; 75 USPQ2d 1801 (Fed. Cir. 2005).

As the opinion in *Datamize* (where the subjective element was the phrase “aesthetically pleasing”) stated

The scope of claim language cannot depend solely on the unrestrained, subjective opinion of a particular individual purportedly practicing the invention. *See Application of Musgrave*, . . . 431 F.2d 882, 893 ([C.C.P.A.] 1970) (noting that “[a] step requiring the exercise of subjective judgment without restriction might be objectionable as rendering a claim indefinite”). Some objective standard must be provided in order to allow the public to determine the scope of the claimed invention. Even if the relevant perspective is that of the system creator, the identity of who makes aesthetic choices fails to provide any direction regarding the relevant question of how to determine whether that person succeeded in creating an “aesthetically pleasing” look and feel for interface screens. A purely subjective construction of “aesthetically pleasing” would not notify the public of the patentee’s right to exclude since the meaning of the claim language would depend on the unpredictable vagaries of any one person’s opinion of the aesthetics of interface screens. While beauty is in the eye of the beholder, a claim term, to be definite, requires an objective anchor.

Id. at 1350, 75 USPQ2d at 1807.

Reference to undefined standards, regardless of whose views might influence the formation of those standards, fails to provide any direction to one skilled in the art attempting to determine the scope of the claimed invention. In short, the definition of “aesthetically pleasing” cannot depend on the undefined views of unnamed persons, even if they are experts, specialists, or academics.

Id. at 1352-3, 75 USPQ2d at 1808.

Thus, claim terms must have some objective standard. As regards the use of a trademark law standard, the court in *Datamize* stated, with reference to design patent law in that particular case, that absent a reasonable relationship between the understanding of a term in utility patent law and another body of law (design

patent law in *Datamize*), a standard in the other body of law does not meet the requirements for such a standard in utility patent law:

We reject *Datamize*'s attempt to rely on an understanding of the phrase "aesthetically pleasing" derived from design patent law. Use of the phrase "aesthetically pleasing" in design patent law relates to the threshold question of patentability. See *Bonito Boats*, 489 U.S. at 148. A design patent protects a particular ornamental, or "aesthetically pleasing" as opposed to functional, design. *Id.* (citing 35 U.S.C. § 171). In contrast, a utility patent protects "any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof," 35 U.S.C. § 101 (2000), the scope of which is defined by the patent's written claims, see *Johnson & Johnston Assocs. v. R.E. Serv. Co.*, 285 F.3d 1046, 1052 (Fed. Cir. 2002) (en banc) ("[C]laims define the scope of patent protection."); see also 35 U.S.C. § 112, ¶2. In light of this basic difference between design patent law and utility patent law, it is clear that the understanding of "aesthetically pleasing" used in design patent law bears no reasonable relationship to utility patent law generally.

Id. at 1354-5, 75 USPQ at 1810.

ANALYSIS

With respect to the rejection of claims 18 and 19 under 35 U.S.C. § 112, first paragraph, as can readily be seen by the above quoted passage from the specification, there is no description of an activity as being the suggested object of the shape of the outer package that contains the thematic package. Instead, the only reference to the shape of the outer package is that it suggests that it contains its contents. This is supported by the drawings of Fig. 5, which portrays an outer package similar in shape to the outer package typically used to contain golf balls, which are the shape of the thematically shaped package. This is the extent to which claim 18, and its dependent claim 19, are described by the original

disclosure. Again, claim 18 was not present upon the Feb. 18, 1997 filing of the application and was not part of the original disclosure as filed. The claimed reference to a suggested activity is outside the perimeter of the scope of the originally filed disclosure.

With respect to the rejection of claims 5, 17 to 24, 27 to 31 and 49 to 58 under 35 U.S.C. § 112, second paragraph, trademark law has even less of a reasonable relationship to utility patent law generally than does design patent law, which the court in *Datamize* held could not support an objective standard for the claim term “aesthetically pleasing” also found in design patent law. The Appellant has pointed to no definition for the term “visually suggestive” that would provide an objective standard under patent law, but instead makes a generic reference to Chapter 1200 of the Manual of Trademark Examining Procedure (Rehearing Request 2-3). Thus, the Appellant has provided no showing of an objective standard for the claim limitations of “visually suggestive”, “recognizable”, or “associated with.” Accordingly, claims 5, 17 to 24, 27 to 31 and 49 to 58 are of indefinite scope.

DECISION

Appellant's request is *granted* to the extent that the decision has been reconsidered.

As the Appellant has not provided any evidence or contention pointing out how claims 18 and 19 are described within the original disclosure, so as to have evidenced possession, specifically with regard to an outer package shaped to visually suggest an activity, as contrasted with being suggestive of its contents, we *deny* the request to withdraw the rejection of rejected claims 18 and 19 under

35 U.S.C. § 112, first paragraph as not being fully described to the extent of the scope of the claim.

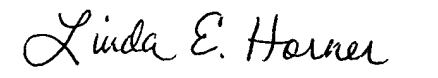
As the Appellant has not provided any evidence pointing out how the characterization of the claimed subject matter as “recognizable”, “visually suggestive”, and “associated with” are not totally subjective to each individual, obviating any possibility of pointing out the scope of the claims with any degree of particularity, we *deny* the request to withdraw the rejection of claims 5, 17 to 24, 27 to 31 and 49 to 58 under 35 U.S.C. § 112, second paragraph.


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No time period for taking any subsequent action in connection with this appeal
may be extended under 37 CFR § 1.136(a).

DENIED


JENNIFER D. BAHR
Administrative Patent Judge


LINDA E. HORNER
Administrative Patent Judge


ANTON W. FETTING
Administrative Patent Judge

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